

Action, the Examiner responds to Applicants' arguments provided in the April 8, 2005 Response to the January 11, 2005 Office Action.

The Examiner first states that Applicants argue the prior art fail to teach an inventive concept of physical characteristics being registered or processed such as a fingerprint to provide identification of a customer. The Examiner then goes on to describe the features of the Brown reference. Applicants respectfully traverse this characterization of Applicants' arguments. Specifically, Applicants have not argued that the prior art has failed to teach registering fingerprints, but that there is no suggestion of incorporating the Brown fingerprinting features into the method disclosed by Yamada based on a traditional package delivery service. That is, there is no suggestion that actual physical characteristics be registered or processed, such as a fingerprint to provide identification of a customer as recited in the independent claims of the present application.

Next, with respect to Applicants' hindsight argument, the Examiner generally cites the case of *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971), but provides no other discussion relating to Applicants' actual arguments included in the April 8, 2005 Response. In that Response, Applicants argued that, based on the Examiner's reasons for combining the references, that the Examiner has improperly rejected the claims for at least three reasons. First, analogous to *Exolochem*, the Examiner has defined the problem in terms of the solution, revealing improper hindsight in the selection of the prior art relevant to obviousness. As stated above, there is no teaching or suggestion in the patents themselves of making this specific combination, particularly as the problem that Yamada solves is how to deliver a package so that

a customer does not have to be at the delivery location when it is delivered. The present invention solves a different problem - that of controlling access to a mail-order site. The present invention solves this problem by using physical characteristics of a person as well as a password.

Second, and equally important, the Examiner states that the reason for combining the references is to provide a system for shopping wherein the customer can order merchandise and designate addresses or places where the goods or merchandise can be delivered. Applicants fail to see how designating a place to deliver goods or merchandise, as taught by Yamada, would motivate one of ordinary skill in the art to incorporate its on-line shopping method into a user authentication system (Brown et al) as the Examiner concludes. Delivery of goods is quite different than controlling access to a mail-order site.

In fact, Yamada is silent with respect to verifying physical characteristics of a customer when ordering, and arguably teaches away from this feature. That is, the discriminating information of a member disclosed in Yamada is used for verification purposes of the delivery, rather than the order (see col. 3, line 65- col. 4, line 3).

Finally, case law provides that the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991) (see also MPEP 2143). For the reasons discussed above, the rejection is "hindsight reconstruction" since the *only* basis for achieving the claimed invention from the combination of Yamada and Brown et al., as proposed by the Examiner, would be impermissible hindsight reliance upon Applicants' own teaching in the present application.

Additionally, Applicants respectfully submit that the USPTO is held to a rigorous standard when trying to show that an invention would have been obvious in view of the combination of two or more references. *See, In re Sang Su Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002), citing, e.g., *In re Dembicza*k, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (“Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.”). In Lee, the Federal Circuit further emphasized that the “need for specificity pervades this authority.” (Lee at 1433 (citing *In re Kotzab*, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (“particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed”)). The factual inquiry into whether to combine references “must be based on objective evidence of record.” Lee at 1433.

In the Office Action, the reasons on which the Examiner concludes that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Brown et al.’s authentication system to include the Yamada mail-order system are that it would have provided a system for shopping wherein a customer can order merchandise and designate addresses or places where the good or merchandise can be delivered. Applicants respectfully submit that this analysis is not sufficient to meet the standards of an obviousness rejection as required by *Lee*.

Finally, the Examiner states that in response to Applicants’ argument that there is no suggestion to combine the references, the Examiner recognizes that obviousness can only be

established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the combination is proper since the inventive concepts in the prior art are in the same environment. First, the connection between Yamada and Brown being in the same environment is tenuous at best. Yamada relates to an on-line shopping method while Brown relates to a user authentication system. Further, *assuming arguendo*, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). In this case, that suggestion is not present.

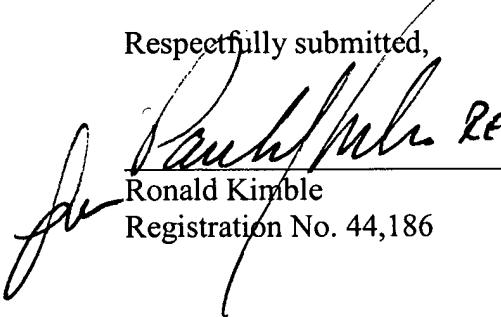
In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

RESPONSE UNDER 37 C.F.R. § 1.116  
U.S. Application No. 09/825,333

Attorney Docket No. Q63916

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

  
Ronald Kimble  
Registration No. 44,186

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON OFFICE  
23373  
CUSTOMER NUMBER

Date: September 30, 2005